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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/898,254	07/03/2001	Jennifer Quirin Trelewicz	IBMN.026US01 (0526)	1933

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Chambliss, Bahner & Stophel, P.C.  
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Chattanooga, TN 37402

EXAMINER

THOMPSON, JAMES A

ART UNIT	PAPER NUMBER
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2624

DATE MAILED: 01/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/898,254

Applicant(s)

TRELEWICZ ET AL.

Examiner

James A. Thompson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 January 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,5,7,8,11,13-18,21 and 23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,2,5,7,8,11,13,14,17,18,21 and 23 is/are allowed.
- 6) ☒ Claim(s) 15 and 16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**EXAMINER'S AMENDMENT**

1. The application has been amended as follows:
  - a. In claim 1, line 7, change "function;" to "function,".
  - b. In claim 2, line 1, change "claim 1 wherein" to "claim 1, wherein".
  - c. In claim 7, line 9, change "function;" to "function,".
  - d. In claim 8, line 1, change "claim 7 wherein" to "claim 7, wherein".
  - e. In claim 11, line 4, change "spot" to "spot.".
  - f. In claim 13, line 1, change "claim 7 wherein" to "claim 7, wherein".
  - g. In claim 14, line 1, change "claim 7 wherein" to "claim 7, wherein".
  - h. In claim 15, line 1, change "claim 7 further" to "claim 7, further".
  - i. In claim 16, line 1, change "claim 7 wherein" to "claim 7, wherein".
  - j. In claim 17, line 9, change "function;" to "function,".
  - k. In claim 18, line 1, change "claim 17 wherein" to "claim 17, wherein".
  - l. In claim 23, line 9, change "function;" to "function,".

## **DETAILED ACTION**

### ***Specification and Drawings***

2. While Examiner has fully considered and checked the specification and drawings for any formal and typographical errors, Applicant is advised to independently inspect the specification, drawings and all amendments for any formal or typographical errors to ensure compliance and correctness.

### ***Response to Amendment***

3. The proposed amendments to the claims, dated 03 January 2006, rewrite claims 1, 7, 17 and 23 to include the allowable subject matter specifically noted in item 9 of the previous office action, dated 16 July 2005 and mailed 26 July 2005. Thus, the **proposed amendments to the claims will be entered.**

### ***Response to Arguments***

4. Applicant's arguments, filed 03 January 2006, with respect to the rejections of the claims under 35 USC §102(b) and 35 USC §103(a) have been fully considered and are persuasive. The rejections of the claims under 35 USC §102(b) and 35 USC §103(a) listed in items 4-8 of said previous office action have been withdrawn.

However, new grounds of rejection under 35 USC §112, 2<sup>nd</sup> paragraph are given below. Accordingly, the prosecution of the application is reopened since these rejections must be addressed.

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***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 15 recites "a print program of a computer for generating the print file, wherein the device comprises screening software loaded into the computer, the computer executing the screening software to perform the halftoning." However, the print program and the screening software, as presently recited, are not embodied in any tangible form. Thus, it is not clear how the print program and the screening software are to be physically a part of the printing system. Therefore, in the recitation of claim 15, Applicant has failed to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 16 recites "wherein the device comprises software loaded into the control unit, wherein the control unit executes the software to perform the halftoning." However, the software, as presently recited, is not embodied in any tangible form. Thus, it is not clear how the software is to be physically a

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part of the control unit and/or the printing system. Therefore, in the recitation of claim 16, Applicant has failed to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

***Allowable Subject Matter***

8. Claims 1, 2, 5, 7, 8, 11, 13, 14, 17, 18, 21 and 23 are allowed.

The following is an examiner's statement of reasons for allowance: Allowable subject matter was originally indicated in items 8-9 of the office action dated 01 February 2005 and mailed 07 February 2005. Applicant's present amendments to the claims incorporate the allowable subject matter into the independent claims. Furthermore, Examiner has been unable to find additional prior art references which would anticipate and/or render obvious the present claims. Accordingly, the present claims 1, 2, 5, 7, 8, 11, 13, 14, 17, 18, 21 and 23 are considered allowable.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

9. Claims 15-16 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

The following is a statement of reasons for the indication of allowable subject matter: Claims 15 and 16 are dependent upon independent claim 7, which has been found allowable, as

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discussed above. The only rejections still remaining for claims 15 and 16 are the rejections under 35 USC §112, 2nd paragraph.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Thompson whose telephone number is 571-272-7441. The examiner can normally be reached on 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



24 January 2006

James A. Thompson  
Examiner  
Art Unit 2624



THOMAS D. [unclear]  
[unclear]